THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 42

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte ROBERT ROUNTREE,
CHARVAKA DUVVURY
and
TATSUROH MAKI

_____

Appeal No. 95-3592
Application 08/109,203[1]

_____

ON BRIEF

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[1] Application for patent filed August 19, 1993. According to appellants, the application is a continuation of Application 07/977,730, filed November 16, 1992, abandoned; which is a con- tinuation of Application 07/767,737, filed September 30, 1991, abandoned.

Before THOMAS, FLEMING and LEE, ***Administrative Patent Judges***.

FLEMING, ***Administrative Patent Judge***.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1 through 4, 6 through 10, 17 through 19 and 21 through 23. Claims 5, 20 and 24 are objected to as being dependent upon a rejected base claim, but would be allowable over the prior art of record if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Appellants' invention relates to an input protection circuitry for sensitive electrical devices such as integrated circuitry. In particular, Appellants disclose on page 6 of the specification that Figure 2 shows an embodiment of the invention, an N-well isolation resistor 10, having heavily doped N+ regions 16 and 18 formed within N-well 14 with region 16 being laterally spaced from region 18. Region 16 is electrically connected to an input bond pad 20. Region 18 is connected to a circuit structure 21 that is to be protected.

On page 7 of the specification, Appellants disclose that the N-well isolation resistor 10 increases in resistance with an increase in voltage to limit the amount of current supplied to the protected circuit structure 21.

Independent claim 1 is reproduced as follows:

1. An isolation stage device for protecting a circuit structure against over-voltage conditions, comprising:

a lightly doped region having a first conductivity type formed in a lightly doped substrate having a second conductivity type;

a first heavily doped region formed at least partially in said lightly doped region having said first conductivity type, said first heavily doped region being electrically connected to a first input node;

a second heavily doped region formed at least partially in said lightly doped region having said first conductivity type, said second heavily doped region being electrically connected to said circuit structure; and

a resistive means being electrically connected between said first heavily doped region and said second heavily doped region having a resistance responsive to the voltage between said first heavily doped region and said second heavily doped region.

The reference relied on by the Examiner is as follows:

Shirato et al. (Shirato) 4,710,791 Dec. 1, 1987

Claims 1 through 4, 6 through 10, 17 through 19 and 21 through 23 stand rejected under 35 U.S.C. § 102 as being anticipated by Shirato or in the alternative under 35 U.S.C. § 103 as being unpatentable over Shirato.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the briefs[2] and the answers[3] for the respective details thereof.

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[2] Appellants filed an appeal brief on August 29, 1994. We will refer to this appeal brief as simply the brief. Appellants filed a reply appeal brief on October 24, 1994. We will refer to this reply appeal brief as the reply brief. The Examiner responded to the reply brief in a supplemental Examiner's answer, mailed January 9, 1995, thereby entering the reply brief. Appellants filed a supplemental reply appeal brief on March 13, 1995. We will refer to this supplemental reply appeal brief as the supplemental reply brief. The Examiner stated in the Examiner's letter dated June 2, 1995 that the reply brief has

been entered and considered but no further response by the Examiner is deemed necessary.

[3] The Examiner responded to the brief with an Examiner's answer, mailed September 19, 1994. We will refer to the Examiner's answer as simply the answer. The Examiner responded to the reply brief with a supplemental Examiner's answer mailed January 9, 1995. We will refer to the Supplemental Examiner's answer as simply the supplemental answer.

OPINION

After a careful review of the evidence before us, we agree with the Examiner that claims 1 through 4, 6 through 10, 17 through 19 and 21 through 23 are anticipated under 35 U.S.C.
§ 102 by Shirato.

At the outset, we note that Appellants have indicated on page 3 of the brief that the claims stand separately. However, we note that Appellants have argued the claims in the briefs as one group. As per 37 CFR § 1.192(c)(5) revised
Oct. 22, 1993 which was controlling at the time of Appellants filing the brief, it will be presumed that the rejected claims stand or fall together unless there is a statement otherwise, and in the appropriate part or parts of the arguments Appellants
present reasons as to why Appellants consider the rejected claims to be separately patentable. We note that on pages 7 through 9, Appellants provide a paragraph for each of claims 2 through 4, 6 through 10, 17 through 19 and 21 through 23.

Each paragraph provides a summary sentence restating the claim limitations followed by an identical sentence of argument. The identical sentence of argument is as follows: The Shirato reference fails to teach or suggest this further limitation in combination with the requirements of claim 1 [for claims 2 through 4, 6 through 10, 17 through 19] or claim 21 [for claims 22 through 23]. Appellants have not presented how the Examiner erred or reasons why Shirato does not teach or suggest the claimed invention. We will, thereby, consider the Appellants' claims as standing or falling together.

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. ***See In re King***, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and ***Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co***., 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984). "Anticipation is established
only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a

claimed invention." ***RCA Corp. v. Applied Digital Data Sys., Inc.***, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.), ***cert. dismissed,*** 468 U.S. 1228 (1984), ***citing Kalman v. Kimberly-Clark Corp.***, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), ***cert. denied***, 465 U.S. 1026 (1984).

Appellants argue in the brief, reply brief and supplemental reply brief that Shirato does not teach a resistive means having a resistance responsive to the voltage. We note that Appellants' claim 1 recites "a resistive means being electrically connected between said first heavily doped region and said second heavily doped region having a resistance responsive to the voltage between said first heavily doped region and said second heavily doped region."

The Examiner argues that Shirato teaches Appellants' claimed resistive means. The Examiner shows that Shirato's element 26 of a cross sectional view of a protection device in Figure 1(a) is a resistive means being electrically connected between said first heavily doped region and said second

heavily doped region having a resistance responsive to the voltage between said first heavily doped region and said second heavily doped region as recited in Appellants' claims. We note that
Shirato teaches an equivalent electrical circuit to the protection device of Figure 1(c). Shirato teaches in column 4,
lines 27-35, that resistor Rw shown in Figure 1(c) is the resistance of element 22 shown in Figure 1(a) and resistor Rp shown in Figure 1(c) is the resistance of element 26 shown in Figure 1(a).

Appellants argue that Shirato's resistive means, element 26 shown in Figure 1(a) and resistor Rw shown in Figure 1(c), does not read on Appellants' claimed resistive means. Appellants argue that because only a small amount of current flows through element 26 with the majority of current flowing through another resistance means, element 26 in Figure 1(a) and resistor Rp shown in Figure 1(c), Shirato's resistive means, element 26, offers no practical benefit as a resistor.

However, we fail to find that the scope of Appellants' claim requires that the resistive means carry all of the current or preclude other resistive means. Our reviewing court states in ***In re Zletz***, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) that "claims must be interpreted as broadly as their terms reasonably allow." We note that Appellants' claims recite "comprising" and thereby Appellants' claims do not preclude other resistive means. In addition, we fail to find any limitations in the claims that require a value of resistance or amount of the current that is to flow through the resistive means.

Appellants further argue that the Examiner is required to consider the function language "having a resistance responsive to the voltage." We note that Appellants and Examiner have argued this issue in the briefs and answers at considerable
length and detail. We find that the Examiner has shown that Shirato does teach resistive means 26 which has a resistance responsive to the voltage. We note that Appellants' broad claim language does not preclude a reading that a resistance

of a constant value to a range of voltages is a resistance responsive to the range of voltages. We note that the claim language recites only “having a resistance responsive to the voltage.” We further note that Shirato’s resistive means has a resistance responsive to the voltage in that the current varies according to the voltage divided by the resistance. Appellants’ claims do not require that the resistance varies with voltage change.

In the supplemental reply brief, Appellants argue that our reviewing court in ***In re Donaldson Co. Inc.***, 16 F.3d 1189,
29 USPQ2d 1845 (Fed. Cir. 1994) held that function language alone was determinative of patentability. However, we note that Appellants did not argue that Appellants' resistive means must be construed to corresponding structure found in Appellants' specification. Furthermore, Appellants do not point to corresponding structure in Appellants' specification. Thus, we find that the Examiner properly interpreted the scope of Appellants' claims.

Therefore, we find that Shirato teaches a resistive means being electrically connected between said first heavily doped region

and said second heavily doped region having a resistance responsive to the voltage between said first heavily doped region and said second heavily doped region as recited in Appellants' claims.

We note that Appellants have not argued that Shirato has failed to meet any of the other limitations of the claims. Appellants have chosen not to argue any of these specific limitations of the claims as a basis for patentability. We are not required to raise and/or consider such issues. As stated by our reviewing court in ***In re Baxter Travenol Labs.***, 952 F.2d 388, 391, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991), "[i]t is not the function of this court to examine the claims in greater detail than argued by an appellant." 37 CFR § 1.192(a) as amended at 58 F.R. 54510, Oct. 22, 1993, which was controlling at the time of Appellants' filing the brief, states as follows:

> The brief . . . must set forth the authorities and arguments on which the

> appellant will rely to maintain the appeal. Any arguments or authorities not included in the brief may be refused consideration by the Board of Patent Appeals and Interferences.

Also, 37 CFR § 1.192(c)(6)(iii) states:

> For each rejection under 35 U.S.C. 102, the argument shall specify the errors in the rejection and why the rejected claims are patentable under 35 U.S.C. 102, including any specific limitations in the rejected claims which are not described in the prior art relied upon in the rejection.

Thus, 37 CFR § 1.192 provides that just as the court is not under any burden to raise and/or consider such issues, this board is not under any greater burden.

In view of the foregoing, the decision of the Examiner rejecting claims 1 through 4, 6 through 10, 17 through 19 and 21 through 23 under 35 U.S.C. § 102 as being anticipated by Shirato or in the alternative under 35 U.S.C. § 103 as being unpatentable over Shirato is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR

§ 1.136(a).

AFFIRMED

JAMES D. THOMAS Administrative Patent Judge	)	
MICHAEL R. FLEMING Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JAMESON LEE Administrative Patent Judge	)	

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